

**REMARKS**

Claims 1-16 and 18-20 are pending in this application.

Applicants respectfully request reconsideration of the rejection of claims 1-16 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over *Mori* (U.S. Patent No. 6,089,765) in view of *Nosaki et al.* (U.S. Patent No. 5,673,373) ("*Nosaki*"). As explained below, the combination of *Mori* in view of *Nosaki* does not raise a *prima facie* case of obviousness against the claimed subject matter because 1) the requisite suggestion to combine the *Mori* and *Nosaki* references is lacking, and 2) the combination of *Mori* in view of *Nosaki* would not have suggested to one having ordinary skill in the art the subject matter defined in independent claims 1, 9, and 18-20.

In the Final Office Action, the Examiner asserts that "[t]he system of *Mori* teaches checking a designation associated with a file that can designate that the file is sensitive or secret information (col. 6 lines 25-30)." Final Office Action at page 2. The cited portion of the *Mori* reference includes the description that "the user can manipulate the input portion 26 either to indicate that the data is prohibited from being reprinted or to specify that the data is intended for reprinting." *Mori* at column 6, lines 30-32. This description constitutes the entirety of the description in the *Mori* reference regarding how the reprinting of data is prohibited. As such, there is no teaching in the *Mori* reference that a selective holder refrains from holding the printing job in the auxiliary memory device even if the set portion is set so that the printing job is still held in the auxiliary memory device when the judging portion judges that the printing job is set to have some secret. Instead, in the print system of *Mori*, the user must indicate for each batch of print data that the print data is prohibited from being reprinted, and the print system judges whether the received data has this indication. Thus, in the print system of *Mori*, even if the print data does not contain an attribute indicating

confidential information, the print data is not held when the user sets the data so as not to be reprinted.

The *Nosaki* reference discloses a print system in which a terminal 1 sends user specific data, data designating the secret print, and print data to a print server 2 via a file server 3 (see Figure 1). The terminal 1 receives print job specific data and a password, and then the user inputs the print job specific data and the password to the print server 2 when the user causes the print server to perform the printing operation for the print data. Thus, the *Nosaki* print system holds the print data until the user inputs the print job specific data and the password. If a memory print mode has been designated, the print data is not erased even when the printing operation has been completed. In the memory print mode, the print system always holds the print data after the printing operation regardless of whether or not the print data is for a secret print. As such, there is no teaching in the *Nosaki* reference that the print system does not hold the print data after the printing operation when the print data is for a secret printing operation.

It is axiomatic that an obviousness rejection based on a combination of references is proper only if there would have been a suggestion in the prior art to combine the references. Applicants respectfully submit that the requisite suggestion to combine the *Mori* and *Nosaki* references is lacking because the print system of *Nosaki* is operates on the premise that the print data is held after the printing operation in the memory print mode even if the print data is for a secret print. In contrast, in the print system of *Mori*, even if the print data does not contain an attribute indicating confidential information, the print data is not held when the user sets the data so as not to be reprinted. In light of this conflict, there would have been no motivation for one having ordinary skill in the art to incorporate the teachings of the *Nosaki* reference into the print system of *Mori* in the manner proposed by the Examiner.

Even if it were to be deemed that the proposed combination of the *Mori* and *Nosaki* references is proper (a proposition with which Applicants do not agree for the reasons set forth above), the result of this combination would not include all of the features specified in independent claims 1, 9, and 18-20. For at least the reasons set forth above, neither *Mori* nor *Nosaki* discloses or suggests a selective holder as defined in the claims (or in the case of the method claims, the method operations performed by the selective holder). As specified in the claims, the selective holder refrains from holding the printing job as printing job data in the auxiliary memory device even if the set portion is set so that the printing job is still held as printing job data in the auxiliary memory device even after printing is completed, when the judging portion judges that the printing job is set to have some secret. The selective holder also holds the printing job as printing job data in the auxiliary memory device when the judging portion judges that the printing job is not set to have some secret and the set portion is set so that the printing job is still held as printing job data in the auxiliary memory device even after printing is completed.

For the reasons set forth above, the combination of *Mori* in view of *Nosaki* does not raise a *prima facie* case of obviousness against independent claims 1, 9, and 18-20 because 1) there is no suggestion in the prior art to combine the *Mori* and *Nosaki* references in the manner proposed, and 2) the result of the combination of the *Mori* and *Nosaki* references would not include all of the features of independent claims 1, 9, and 18-20. Accordingly, independent claims 1, 9, and 18-20 are patentable under 35 U.S.C. § 103 over the combination of *Mori* in view of *Nosaki*. Claims 2-8, each of which ultimately depends from claim 1, and claims 10-16, each of which ultimately depends from claim 9, are likewise patentable under 35 U.S.C. § 103 over the combination of *Mori* in view of *Nosaki* for at least the same reasons set forth above regarding the applicable independent claim.

**Application No. 09/934,678**  
**Request for Reconsideration dated February 2, 2006**  
**Response to Final Office Action mailed November 2, 2005**

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-16 and 18-20, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. KYWAP004).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, L.L.P.



Peter B. Martine  
Reg. No. 32,043

710 Lakeway Drive, Suite 200  
Sunnyvale, California 94085  
**Customer Number 25920**